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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,143	01/21/2000	William J. Baer	STL920000020US1 09200041C	5414
46157 7590 04/01/2010 EDELL, SHAPIRO, & FINNAN, LLC 1901 RESEARCH BOULEVARD, SUITE 400 ROCKVILLE, MD 20850			EXAMINER BASEHOAR, ADAM L	
			ART UNIT 2178	PAPER NUMBER
			NOTIFICATION DATE 04/01/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

Office Action Summary	Application No. 09/489,143	Applicant(s) BAER ET AL.	
	Examiner ADAM L. BASEHOAR	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 12/16/09.
2. All previous rejections to the claims have been withdrawn as necessitated by Amendment.
3. Claims 1-24 pending. Claims 1, 9, and 17 are independent.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 12/16/09 has been considered by the examiner.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 7-8, 9-10, 15-18, 23 and 24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (US-6,147,768 11/14/00) in view of Ogawa (US-6,072,479 06/06/00).

-In regard to substantially similar independent claims 1, 9, and 17, Norris teaches a computer-implemented method, medium, and system for determining the cost of and producing a user-defined content object comprising:

defining said content object (“photographic album”) in accordance with user selection and arrangement (Fig. 3: “mats”) of a plurality of content entities (“photographic image”) for

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said content object ("photographic album")(column 4, lines 53-67; column 5, lines 1-24; column 7, lines 49-67; column 8, lines 1-67; column 9, lines 1-13)(Figs. 2 & 3), wherein the content object is a digital object within the computer in the form of one of a book, a collection of images, an album, a video and a multimedia object (i.e. the photographic album is a collection of images), and the content entities each include content comprising digital data ("video images" & "size of the selected image"), are stored within a data repository as a plurality of individually accessible file objects (column 7, lines 65-67; column 8, lines 1-24)(Fig. 2), and are selectively associated with an actual content count representing the quantity of content within that content entity (column 7, lines 65-67; column 8, lines 1-40: "number of each size print is counted"); and generating a price for the user to produce the user-defined content object, wherein said price is one of an actual price based on a parameter setting (column 5, lines 16-22: "price database...prices for various sized pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture sizes selected...their selected page locations"; column 8, lines 35-40: "the number of each size print is counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of the selected images"), wherein the quantity of content of content within the content object could be determined via the digital data within the selected content entities (column 6, lines 12-22: "calculate a customer invoice...picture sizes selected...their selected page locations"; column 8, lines 35-40: "the number of each size print is counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of the selected images") and said price generation includes and generating the actual price to serve as the price for the user to produce the user- defined content object from the

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actual content counts of the selected content entities in response to said parameter setting indicating the actual price (column 5, lines 16-22: "price database...prices for various sized pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture sizes selected...their selected page locations"; column 8, lines 35-40: "the number of each size print is counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of the selected images").

Norris teaches wherein printing photographic albums can be costly and a general motivation for decreasing the expense of printing electronic photo albums (column 1, lines 37-54: "costly...adding expense to the project...eliminating the cost"). Norris does not specifically teach generating an estimated content count for the selected content entities that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count representing the estimated quantity of content within the content object, and generating from the estimated content count the estimated price to serve as the price for the user to produce the user defined content object with the selected content entities in response to said parameter setting indicating the estimated price, wherein the estimated price is determined based on a price per unit of content, and wherein the unit of content represents a predetermined quantity of content and the estimated content count indicates an estimated quantity of said units of content for the selected content entities. Ogawa teaches generating an estimated content count for the selected content entities that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count representing the estimated quantity of content within the content object, and generating

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from the estimated content count the estimated price to serve as the price for the user to produce the user defined content object with the selected content entities in response to said parameter setting indicating the estimated price, wherein the estimated price is determined based on a price per unit of content, and wherein the unit of content represents a predetermined quantity of content and the estimated content count indicates an estimated quantity of said units of content for the selected content entities (column 1, lines 13-15: "creating multimedia applications"; column 2, lines 41-54: "estimate the size of the data...cost"; column 3, lines 20-46: "media objects or inputting existing media objects....media dependent attribute of an actual media object...calculation module calculating sizes of the actual media data...to estimate the total size of an overall application...adds up actual media creation costs for calculation of an estimate of the cost of each media type and an overall application"; column 4, lines 6-46: "surrogate media objects representing actual media objects including moving picture objects, voice objects, and/or images...user to enter media-dependent attributes...estimating the size...estimating total cost"; column 5, lines 29-35; column 11, line 45-column 12, line 63: "reads media attribute information...calculates the data size of each object...may be used as a transfer data amount estimate...one scene at a time...user to estimate costs"; column 13, line 45-column 14, lines 37: "calculate the costs only for user-selected media types...allow the user to enter a cost...displays the cost calculated")(Figs. 11 & 12). It would have been obvious to one of ordinary skill in the art the time of the invention for the system of Norris to have included the estimated content count/cost feature of Ogawa, because Ogawa taught that by determining an estimated content size/count and subsequent estimated cost/price of a specific content entity the user would be provided the benefit of making an informed decision about the cost/size of said entity (column 2,

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lines 41-67: "important to estimate the size of data...poor application quality...lower development costs...keep track of progress").

-In regard to substantially similar independent claims 2, 10, and 18, Norris teaches wherein the step of generating an estimated content count further comprises the steps of determining an estimated content count for each selected content entity, and summing the entity content counts to obtain the estimated content count for the content object (column 8, lines 35-40: "the number of each size print is counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of the selected images"). Additionally, for similar benefits as disclosed above, Ogawa also teaches determining an estimated content count for each selected content entity and summing the entity content counts to obtain the estimated content count for the content object (Fig. 11: 114, 115, 117, 1110, 1111, 1112).

-In regard to substantially similar independent claims 7, 15, and 23, Norris teaches wherein the content object further comprises user-provided content, and wherein generating a price for the content object further comprises the steps of separately determining a price for user-provided content and generating the selected estimated or actual price by summing the user-provided content price with the price determined for the remaining selected content entities of the content object (column 3, lines 25-58: "capturing video images to be entered into a database"; column 5, lines 22-45; column 5, lines 16-22: "price database...prices for various sized pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture

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sizes selected...their selected page locations”; column 8, lines 1-40: “notes associated with the displayed photographs can be added...the number of each size print is counted and then multiplied out by the price per unit”; column 9, lines 10-14; column 10, lines 4-17: “price is generally determined by the number and size of the selected images”).

-In regard to substantially similar independent claims 8, 16, and 24, Norris teaches wherein the price for user-provided content is determined in a first manner if the content count of the user- provided content exceeds a predefined content count maximum, and is determined in a second manner if the content count does not exceed the predefined maximum (column 4, lines 64-67; column 5, lines 1-22: “price database...prices for various sized pictures and various mats”; column 6, lines 12-22: “calculate a customer invoice...picture sizes selected...their selected page locations” & 63-67: “automatically sizes each image to accommodate all sizes which are necessary for use with a particular mat manufacture selected”; column 8, lines 1-40: “notes associated with the displayed photographs can be added...the number of each size print is counted and then multiplied out by the price per unit”; column 9, lines 10-14; column 10, lines 4-17: “price is generally determined by the number and size of the selected images”)(Fig. 3).

7. Claims 3-6, 11-14, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (US-6,147,768 11/14/00) in view of Ogawa (US-6,072,479 06/06/00) in further view of Dedrick (US-5,768,521 6/16/98).

-In regard to substantially similar independent claims 3, 11, and 19, Norris teaches wherein the selected content entities could contain text characters (column 8, lines 1-24:

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"notes"). Norris does not specifically teach determining an estimated content count for entities containing characters comprises the step of determining a character count for the entity. Dedrick teaches a method of metering the flow of electronic information to a client computer (Abstract). Dedrick teaches determining a unit of information count for the content entity (a digital entry)(column 1, line 62 – column 2 line 22; column 3 lines 60-63; column 4 line 26 – column 5 line 25; and column 7 lines 29-43). Dedrick specifically teaches estimating a content count for each content entity may be calculated in bytes or words in (column 4, lines 63-64; column 5, lines 10-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to applying the per byte/word character count of Dedrick to the calculation and counting system of Norris, because Norris would have been provided the benefit of applying metering to virtual objects such as online books, digital directories etc (column 4, lines 65-67: “desirable when the end user is accessing a database that contains...drawings and text”; column 5, lines 1-2).

-In regard to substantially similar independent claims 4, 12, and 20, Norris teaches wherein the step of determining an estimated content count further comprises the step of determining a page count from the character count (column 8, lines 1-53: "Pages 116...all changes are reflected in the next invoice generated"). Additionally, for similar benefits as disclosed above, Dedrick teaches specific examples that the content count unit may be in bytes or words in (column 4, lines 63-64; column 5, lines 10-25). Determining a page count from the character count is merely changing the units of the count from characters to pages. Dedrick teaches an information unit count of bytes in column 4, lines 63-64 and megabytes in column 5,

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lines 21-23. The two example units of Dedrick are related exactly as the characters and pages of the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied Dedrick to Norris, providing Norris the benefit of converting characters/images into pages so that the cost computation would have been simplified.

-In regard to substantially similar independent claims 5, 13, and 21, Norris does not specifically teach wherein the step of determining a character count further comprises at least one of: counting the number of content characters in the content entity and determining the content entity type, and determining an average character count for content entities of that type. Dedrick teaches determining a unit of information count for a content entity based on counting the number of content characters in the content entity (column 4, lines 63-64; column 5, lines 10-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to counting the number of the per byte/word character count of Dedrick to the calculation and counting system of Norris, because Norris would have been provided the benefit of applying metering to virtual objects such as online books, digital directories etc (column 4, lines 65-67: “desirable when the end user is accessing a database that contains...drawings and text”; column 5, lines 1-2).

-In regard to substantially similar independent claims 6, 14, and 22, Norris teaches wherein the step of generating a content object price further comprises multiplying the page

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count with a predetermined price per page value (column 8, lines 1-53: "Pages 116...all changes are reflected in the next invoice generated...multiplied out by the price per print").

Response to Arguments

8. Applicant's arguments with respect to claims 1, 9, and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Please note the additionally cited references on the accompanying PTO-892 Form.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM L. BASEHOAR whose telephone number is (571)272-4121. The examiner can normally be reached on M-F: 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam L Basehoar/
Primary Examiner, Art Unit 2178